

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OSCAR J. RUIZ
and MATHEW K. SHAFE

Appeal No. 1998-1547
Application No. 08/582,001

ON BRIEF

Before KRASS, FLEMING, and HECKER, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6 and 21-26, all of the claims pending in the application.

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The invention is directed to a head suspension assembly in a disk drive for supporting and positioning electromagnetic heads for transduction with one or more recording disks mounted on a rotatable spindle.

Independent claim 1 is representative of the invention and is reproduced as follows:

1. A suspension assembly for supporting a transducer in a disk drive comprising:

a suspension member with a multilayer laminate stock having a mount plate area defined therein,

said mount plate area comprising:

a plurality of metal layers clad to one another, and

at least one etch retardant layer received between a first pair of said plurality of metal layers; and

the said etch retardant layer is a metal selected from group consisting of gold, tungsten, and nickel.

The examiner relies on the following reference:

Erpelding et al. [Erpelding]	4,996,623	Feb.
26, 1991		

Claims 1-6 and 21-26 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-6 and 21-26 stand further rejected under 35 U.S.C. § 103 as unpatentable over Erpelding.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

Turning first to the rejection under 35 U.S.C. § 112, second paragraph, the examiner contends that the claims are indefinite and incomplete because it was unclear what comprised certain structures and where other structures within a suspension assembly would be located.

Without reaching the merits of this rejection, we will summarily sustain the rejection of claims 1-6 and 21-26 under 35 U.S.C. § 112, second paragraph, because appellants have failed to respond to the examiner's rejection in either the principal brief or the reply brief. Appellants have chosen not to argue specifically the examiner's rejection based on 35 U.S.C. § 112. We are not required to raise and/or consider an issue not raised by appellants even though plausible arguments against a rejection may, possibly, have been made. As stated by our reviewing court in In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant..." 37 CFR § 1.192 makes it clear that just as the court is not under any burden

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to raise and/or consider issues not argued by an appellant,
this board is also under no such burden.

We now direct our attention to the rejection of claims 1-
6 and 21-26 under 35 U.S.C. § 103 as unpatentable over
Erpelding.

Independent claims 1 and 21 each recite that the etch
retardant layer is "a metal selected from the group consisting
of gold, tungsten, and nickel." The examiner recognizes that
Erpelding fails to disclose an etch retardant layer made of
gold, tungsten or nickel but contends that it would have been
obvious "to utilize the materials listed" because Erpelding
"is not limited to the materials listed therein" and that
skilled artisans "would have utilized any suitable material"
since the "listed materials are obvious results of routine
optimizing" [answer-page 4].

We find the examiner's conclusion of obviousness to be
unsupported by the evidence before us. The only references to
etching in the disclosure of Erpelding, at column 4, line 65
and column 5, line 7, do not indicate anything about an "etch
retardant layer," as claimed. Thus, it is unclear from
Erpelding whether the polyimide layer 10 between the metal

layers 12 and 14 is, in fact, an "etch retardant layer." What is clear is that Erpelding discloses layer 10 only as a "plastic material, preferably polyimide" [column 3, lines 66-67] and never as a metal layer at all, let alone a metal layer of gold, tungsten or nickel, as required by the instant claims. So, even though the polyimide layer may be an etch retardant layer,¹ there is no suggestion at all in Erpelding that would have led a skilled artisan to employ gold, tungsten or nickel as an etch retardant layer. The only suggestion for using these materials comes from appellants' own disclosure. Thus, it would appear that the examiner's conclusion of obviousness is based on impermissible hindsight.

At page 5 of the answer, the examiner states that the "materials recited in the claims are known equivalents to the polyimide listed in the reference." However, there is no indication by the examiner as to what evidence is being relied on for determining that these materials are "equivalent" nor is there any indication as to for what purposes they are allegedly "equivalent."

¹Appellants' own alternative embodiment, disclosed at page 16 of the specification, indicates that a thermoplastic polyimide can be used to form the etch-stop layer.

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The examiner's rationale of utilizing the claimed materials as "routine optimizing of the structure" [answer-page 5] is unconvincing as it is not clear what is being "optimized." If it is the ability to more finely tune the dimensions of the final structure of the suspension assembly, the examiner has not explained why the artisan would have been led, from the teaching of Erpelding of a polyimide layer between two metal layers, to employ an etch retardant layer of either gold, tungsten or nickel and why the use of such materials would somehow "optimize" the structure.

We will not sustain the rejection of claims 1 and 21 under 35 U.S.C. § 103 since, in our view, the examiner has not established a prima facie case of obviousness. Claims 2-6 and 22-26 will stand with the independent claims.

We have, pro forma, sustained the rejection of claims 1-6 and 21-26 under 35 U.S.C. § 112, second paragraph, but we have not sustained the rejection of claims 1-6 and 21-26 under 35 U.S.C. § 103.

Accordingly, the examiner's decision is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

	Errol A. Krass)	
	Administrative Patent Judge)	
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)	
	Michael R. Fleming)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Stuart N. Hecker)	
	Administrative Patent Judge)	

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